

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAY DEE KRULL, MICHAEL CHILDS,
MATTHEW C. BURCH, BENJAMIN JONES, and PAUL MCALISTER

Appeal 2007-3168
Application 10/032,032
Technology Center 3600

Decided: November 13, 2007

Before MURRIEL E. CRAWFORD, LINDA E. HORNER, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

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DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-22 and 28-38. Claims 23, 25, 27 have been allowed. Claims 24, 26, 39 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We AFFIRM¹.

¹ Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not

THE INVENTION

The Appellants' claimed invention is directed to integrating a Personal Digital Assistant (commonly referred to as a PDA) with Global Positioning System (GPS) receiver technology (Specification, page 3). Claims 1 and 14, reproduced below are representative of the subject matter of appeal.

1. A method, comprising:
 - identifying a location;
 - associating a Personal Digital Assistant (PDA) address book entry with the location to form a waypoint; and
 - wherein the location is identified and the PDA address book entry is associated therewith within one portable hand-held device, thereby integrating PDA address book functions with Global Positioning System (GPS) capabilities in a single device.
14. A computer-readable medium having computer-executable instructions adapted to associate a Personal Digital Assistant (PDA) address book entry with a location on an electronic map that is capable of being displayed on the PDA.

THE REJECTION

The Examiner relies upon the following as evidence in support of the rejections:

YOKOYAMA

US 5,654,908

August 5, 1997

to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The following rejection is before us for review:

1. Claims 1-22 and 28-38 are rejected under 35 U.S.C. § 103(a) as unpatentable over Yokoyama.

THE ISSUE

At issue is whether the Appellants have shown that the Examiner erred in rejecting the claims 1-22 and 28-38 under 35 U.S.C. § 103(a). The issue turns on whether the Appellants have shown that the Examiner erred in determining that a person of ordinary skill in the art would have had a reason to modify the device and method disclosed in Yokoyama so as to integrate the Personal Digital Assistant (PDA) address book functions with the Global Positioning System (GPS) capabilities in a single device.

FINDINGS OF FACT

We find the following enumerated findings of fact:

1. Yokoyama discloses a hand-held electronic diary (PDA) device that stores address book entries (col. 2, ll. 27-31; fig. 10, S108).
2. The Yokoyama PDA device communicates the address data to a separate GPS unit (col. 2, ll. 33-37; fig. 2).
3. The Yokoyama GPS system includes an image display unit (56) which includes maps, routes, and an arrow showing the direction of travel (col. 5, ll. 36-40).

4. The Yokoyama GPS system obtains the coordinates of destination based on the address data and establishes the intended route to the destination (col. 6, ll. 16-22).

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S.Ct. at 1739 (citing *Graham*, 383 U.S.

at 12 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” The Court also stated “[i]f a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 1740. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.* at 1741 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

ANALYSIS

The Examiner finds that Yokoyama includes a personal digital assistant (PDA) which transmits the location of an address to a separate GPS system. The Examiner reasons that the combination of the PDA device and GPS system into one single device would have been obvious to one of

ordinary skill in the art to shrink electronics to a smaller space and to cut costs (Ans. 3).

The Appellants first argue with respect to claims 1 and 7 that Yokoyama teaches one device to identify an address, and a completely separate device to associate the address with a location on a map (App. Br. 11: 3-10). The Appellants argue Yokoyama's teachings provide specific utility in the PDA being separately portable (App. Br. 16: 17-18) and not being tied up in calculating the route to the address (App. Br. 16: 8-9), and that for these reasons the combination would not have been made.

The Appellants' arguments in this regard are not persuasive. One of ordinary skill in the art clearly would have recognized the predictable advantage to be gained by combining the GPS and PDA into a single hand-held device i.e., user convenience. By combining the PDA and the GPS to form one device, the system would clearly be much more convenient for the user since only one device, not two would be required. Further, when combined, each portion of the combined device is performing the same function as it performed in the separate devices. "[W]hen a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious." *KSR*, 127 S. Ct. at 1740 (quoting *Sakraid v. Ag Pro, Inc.*, 425 U.S. 273, 282 (1976)).

The Appellants argue with respect to claims 14-17 and 19-21 that Yokoyama fails to show "an electronic map that is capable of being displayed on the PDA" (App. Br. 12: 1). We do not find this argument persuasive. Yokoyama describes an electronic map as being included with

the GPS system (Finding of Fact 3). Therefore the capacity of displaying an electronic map would also be included in a combined PDA/GPS device, and the Appellants have not effectively argued that including the capability of displaying an electronic map in the combined PDA/GPS device would be beyond the skill of one having ordinary skill in the art. *See KSR*, 127 S. Ct. at 1740.

Appellants state that claims 28, 30, 32, 33, and 35-37 require that “the device is adapted to associate a location that is capable of being displayed on the electronic map with a PDA address book entry to form a waypoint” (App. Br. 14: 3-5). The Appellants argue that Yokoyama requires his navigation apparatus 50 to provide mapping capabilities which his electronic diary (PDA) cannot provide. We find this argument also unpersuasive. The proposed combination of the PDA device and the GPS device will provide the electronic map with a waypoint from the address book entry as claimed.

CONCLUSIONS OF LAW

We conclude that Appellants have failed to show that the Examiner erred in rejecting claims 1-22 and 28-38 under 35 U.S.C. § 103(a) as unpatentable over Yokoyama.

DECISION

The decision of the Examiner to reject claims 1-22 and 28-38 is affirmed.

AFFIRMED

Appeal 2007-3168
Application 10/032,032

JRG

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